

August 4, 2004
Case No.: GP-301187 (2760/5)
Serial No.: 09/997,761
Filed: November 29, 2001
Page 9

-- REMARKS --

Claims 1-30 remain under consideration. Claim 19 was amended to correct an inadvertent typographical error. Claims 1, 12 and 20 have been amended to more particularly point out and distinctly claim the Applicants' invention. No new matter has been added with the amendment of claims 1, 12, 19 and 20.

A. Claim 19 was rejected under 35 U.S.C. § 112 as indefinite.

The amendment to claim 19 to reflect proper dependency has obviated the Examiner's rejection. Withdrawal of the rejection to claim 19 is requested.

B. Claims 1-6, 8-16 and 18-30 were rejected under 35 U.S.C. § 102(e) as being anticipated by Bhatia et al. (U.S. Publication Number 2002/0090932).

The rejection of claims 1-6, 8-16 and 18-30 as anticipated by Bhatia et al. under 35 U.S.C. § 102(e) is traversed.

For this § 102(e) rejection to stand, each and every element of independent claims 1, 12 and 20 must be disclosed in at least as great of detail as claimed in the reference. At a minimum, Bhatia et al does not disclose "configuring the service corresponding to the service request based on the vehicle delivery-enabling information, wherein the service is configured at a service management subsystem" as recited in amended claim 1. At most, Bhatia et al discloses sending information received from a vehicle to a content provider via a telecommunications network, the content provider then customizing the information that is sent back to the send back telecommunications network for delivery to the vehicle. As disclosed in Bhatia:

August 4, 2004
Case No.: GP-301187 (2760/5)
Serial No.: 09/997,761
Filed: November 29, 2001
Page 10

The B2B engine 210, upon receipt of the real-time status information, forwards the real-time data to the content providers, thereby permitting customization according to the respective user's real-time situation and preferences. (See Bhatia at paragraph 0046).

This subscriber information is gathered for each user and supplied to the content providers, which provide the information to the mobile subscriber. The restaurant information 105, weather information 110 and portals 115 are customized according to the real-time status of the user, and provided from the B2B engine 210 to the content providers in real-time time, by the B2B engine 210 regarding the real-time status, requirements, preferences, rules and/or location of the subscribed user. (See Bhatia at paragraph 0047).

Therefore, it is readily apparent from the above that the content provider is separate and distinct from the telecommunications network and that it is the content provider that performs the customization, thereby directly teaching away from the Applicants claimed invention.

Because Bhatia et al does not disclose this element of the claimed invention, claim 1 cannot be anticipated by Bhatia et al. Withdrawal of the rejection of claim 1 is requested. Claims 2-5 and 8-11 depend directly or indirectly from claim 1 and are patentable over Bhatia et al for at least the same reasons. Withdrawal of the rejections of claims 2-5 and 8-11 is requested.

Similarly, Bhatia et al does not disclose "means for configuring the service corresponding to the service request based on the vehicle delivery-enabling information ... wherein the means for configuring the service are located at a service management subsystem" as recited in amended claim 12. Again, Bhatia et al discloses that the customization of information is performed at a content provider, separate and distinct from the telecommunications network.

August 4, 2004
Case No.: GP-301187 (2760/5)
Serial No.: 09/997,761
Filed: November 29, 2001
Page 11

Because Bhatia et al does not disclose this element of the claimed invention, claim 12 cannot be anticipated by Bhatia et al. Withdrawal of the rejection of claim 12 is requested. Claims 13-16 and 18-19 depend directly or indirectly from claim 12 and are patentable over Bhatia et al for at least the same reasons. Withdrawal of the rejections of claims 13-16 and 18-19 is requested.

Finally, Bhatia et al does not disclose "computer readable program code that configures the service corresponding to the service request based on the vehicle delivery-enabling information ... wherein the service is configured at a service management subsystem" as recited in amended claim 20. Again, at most, Bhatia et al discloses that the customization of information is performed at a content provider, separate and distinct from the telecommunications network.

Because Bhatia et al does not disclose this element of the claimed invention, claim 20 cannot be anticipated by Bhatia et al. Withdrawal of the rejection of claim 20 is requested. Claims 21-30 depend directly or indirectly from claim 20 and are patentable over Bhatia et al for at least the same reasons as claim 20. Withdrawal of the rejections of claims 21-30 is requested.

August 4, 2004
Case No.: GP-301187 (2760/5)
Serial No.: 09/997,761
Filed: November 29, 2001
Page 12

C. Claims 7, 17 and 26 were rejected under 35 U.S.C. §103(a) as unpatentable over Bhatia et al. in view of Doi et al. (U.S. Publication Number 2001/0014911).

The rejection of claims 7, 17 and 26 under §103(a) is traversed. For this §103(a) rejection to stand, each and every element of claims 7, 17 and 26 must be taught or suggested in at least as great a detail as contained in the art. Furthermore, there must be some motivation or suggestion, *in the art itself*, to combine the references to arrive at the claimed invention. Because the art, alone and in combination fails to teach or suggest configuring the service corresponding to the service request based on the vehicle delivery-enabling information, wherein the service is configured at a service management subsystem (as similarly claimed and discussed above relating to amended independent claims 1, 12 and 20), and there is no motivation to combine the references, the rejection cannot stand.

Claims 7, 17 and 26 depend directly or indirectly from independent claims 1, 12 or 20, respectively and therefore contain each and every element of claims 1, 12 or 20. Therefore, the prior art, alone and in combination, fails to teach or suggest each and every element of claims 7, 17 and 26 for at least the reasons given above. Furthermore, where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 and *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (where an independent claim is non-obvious, any claims depending therefrom are also non-obvious.).

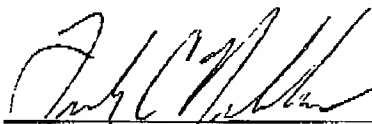
August 4, 2004
Case No.: GP-301187 (2760/5)
Serial No.: 09/997,761
Filed: November 29, 2001
Page 13

CONCLUSION

The Applicants respectfully submit that claims 1-30 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: August 4, 2004

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113



Frank C. Nicholas
Registration No. 33,983
Attorney for Applicants